Supreme Court, U.S.
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No. _____

In The Supreme Court of the United States

October Term, 1998

VECTRA FITNESS, INC.,

Petitioner,

v.

TNWK CORPORATION
(formerly known as PACIFIC FITNESS CORPORATION),

Respondent.

ON PETITION FOR WRIT FOR CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR WRIT FOR CERTIORARI

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QUESTIONS PRESENTED

1. Whether a court engaging in statutory construction must attempt to effect the intent of Congress or, alternatively, can disregard Congressional intent where the statutory language appears to be unambiguous?

2. Whether the lower courts erred in disregarding Congressional intent in considering the relationship between the patent reissue and patent disclaimer statute?

3. Whether the filing of a statutory disclaimer (35 U.S.C. § 253) affects the definition of "original patent" under the patent reissue statute (35 U.S.C. § 251), which otherwise allows a patentee to obtain reissue claims at any time narrower than those of the "original patent"?

4. Whether the lower court erred in invalidating claims 28-30 of United States Patent No. Re. 34,572, a reissue patent, on the basis that the reissue claims were broader than those in the "original patent?"

LIST OF PARTIES

Plaintiff/Petitioner is Vectra Fitness, Inc.

Defendant/Respondent is TNWK Corporation, formerly known as Pacific Fitness Corporation.

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CITATION OF OPINIONS AND ORDERS

The District Court opinion was not reported. The Court of Appeals for the Federal Circuit's opinion is reported at *Vectra Fitness, Inc. v. TNWD,* 162F.3d 1379 (Fed. Cir. 1998).

STATEMENT OF JURISDICTION

The judgment of the Court of Appeals was entered on December 13, 1998, and the petitioner's request for rehearing was denied on January 20, 1999. The Court has jurisdiction pursuant 28 U.S.C. § 1254(1) and Supreme Court Rule 13.

STATUTES AT ISSUE

The following two statutes are at issue:

§ 253 Disclaimer

> Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded

in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him. In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

§ 251 Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

> The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.
>
> No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

STATEMENT OF THE CASE

The Procedural Background

The United States District Court for the Western District of Washington (Dimmick, J.) granted summary judgment that claims 28-30 of United States Patent No. Re. 34,572 ("the '572 patent") are invalid. The district court had jurisdiction over the case because it arose under the patent laws. 28 U.S.C. § 1338(a).

Vectra timely moved to certify the case for interlocutory appeal pursuant to 28 U.S.C. § 1292(b), and the district court granted the motion. On January 22, 1998, the United States Court of Appeals for the Federal Circuit granted Vectra permission to appeal. On December 14, 1998, a panel of the Federal Circuit affirmed, holding that the plain meaning of the statutory language "part of the

original patent" in the disclaimer statute (35 U.S.C. § 253) mandated the outcome. The Federal Circuit did not consider the Congressional purpose underlying the relevant statutes or the specific purpose of the "part of the original patent" language in the disclaimer statute. Vectra petitioned for rehearing, but the petition was denied on January 22, 1999.

The Pertinent Facts

The '572 patent is a reissue of United States Patent No. 4,809,972, which issued on March 7, 1989 ("the '972 patent"). After the issuance of the '972 patent, Vectra learned that the broadest claims of the '972 patent were likely invalid in light of certain prior art. Accordingly, pursuant to 35 U.S.C. § 253 (the disclaimer statute), Vectra mailed a disclaimer of the broad claims to the Patent and Trademark Office ("PTO") on February 16, 1990. The disclaimer was submitted because Vectra believed it had a duty to inform the PTO and the public of claims that it knew to be invalid.

Even though Vectra submitted the disclaimer, the PTO did not acknowledge that it had received the disclaimer, and the disclaimer was not published (as is required under the PTO rules) in the *Official Gazette*.

On May 9, 1991, more than two years after the issuance of the '972 patent, but before any publication of the disclaimer, Vectra sought reissue of the patent pursuant to the reissue statute--35 U.S.C. § 251. In the reissue application, Vectra explained it had submitted a disclaimer of the broad claims, but never had received any

acknowledgment the disclaimer had been received or published.

In the '572 reissue application, Vectra added additional claims 28-30 which were narrower than the original claims of the original '972 patent, but broader, in some respects, than the non-disclaimed claims of the '972 patent. Vectra explained all pertinent facts to the PTO, including the facts concerning the attempted disclaimer of the broad claims. The PTO allowed the additional claims and reissued the patent.

The District Court Decision

The district court held that the PTO erred in issuing the '572 patent. The court held that the claims were broader than those of the "original patent" in violation of the reissue statute. The court conceded the claims were not broader than the claims actually issued with the original '972 patent. Nevertheless, the court held that the term "original patent" should not include claims that Vectra attempted to disclaim. In particular, the district court relied on the statement in 35 U.S.C. § 253 that the disclaimer "shall [after recording] be considered as part of the original patent." The district court essentially incorporated that statement into the reissue statute, 35 U.S.C. § 251, in interpreting the latter's reference to the "original patent."

The district court conceded that it was considering a "narrow issue of first impression: whether the rule that disclaimers date back to the original patent issuance should apply for purposes of determining whether a subsequent reissue on the same patent impermissibly broadens the

scope of the patent."

The district court rejected Vectra's arguments then the Congress never intended the reference in the disclaimer statute to "part of the original patent" to affect a patentee's right to seek reissue. The district court held that even if the purpose was different, "the statute has not been amended" and "this argument should be made to Congress, not the courts." The district court also rejected Vectra's argument that the disclaimer was never "recorded," because it was never published or made publicly available.

The Federal Circuit Decision

The Federal Circuit affirmed, first holding that the disclaimer had been "recorded" pursuant to 35 U.S.C. § 253, because the request for disclaimer had been received by the PTO in proper form. Op. at 5 ("There's no dispute that Vectra's disclaimer was received by the PTO in proper form and with the appropriate filing fee on February 20, 1990. Accordingly, the disclaimer was recorded on that date regardless of its handling by the PTO.").

With respect to statutory construction, the Federal Circuit emphasized it would rely on the "plain meaning" of the statutes:

> Turning to the matter of the disclaimer and the reissue, we begin our analysis with the language of the statute. *See Zenith Elec. Corp. v. United States*, 77 F.3d 426, 430 (Fed. Cir. 1996). Where "the statute's language is plain, 'the sole function of the courts is to enforce it according to its

> terms.'" *United States v. Ron Pair Enters., Inc.*, 489 U.S. 235, 241, 109 S. Ct. 1026, 1030, 103 L. Ed. 2d 290 (1989)(quoting *Caminetti v. United States*, 242 U.S. 470, 485, 37 S. Ct. 192, 194, 61 L. Ed. 442 (1917)).

Op. at 6.

The Federal Circuit then noted that the "validity of claims 28-30 depends upon whether or not the disclaimed claims are considered part of the 'original patent,' as that term is used in Section 251." Op. at 7. The court noted that both parties claimed that the "plain meaning" of the statute supported their position:

> Vectra argues that the plain meaning of the term "claims of the original patent" in 35 U.S.C. § 251 refers to the claims contained in the patent when it issued, unaffected by any disclaimer pursuant to 35 U.S.C. § 253. TNWK counters that the plain language of 35 U.S.C. § 253 and the pertinent case law indicates that a disclaimer becomes a part of the original patent and that the disclaimed claims are viewed as if they never existed.

Op. at 7.

The Federal Circuit agreed that the case presented "a narrow issue of first impression . . . ." Op. at 4. The Federal Circuit noted that prior case law suggested, in other circumstances or in *dicta*, that after a disclaimer is filed, "the patent is viewed as though those disclaimed claims never existed." Op. at 7. Based on these authorities, none

of which relate to reissue applications, the panel held that "original patent" in the reissue statute does not literally mean the "original patent." Op. at 8. ("Consequently, when Vectra invoked section 253 and disclaimed the broadest claims in the '972 patent, it effectively eliminated those claims from the original patent.")

The Federal Circuit held that this result was also justified by a principle of statutory construction:

> The term 'original patent' is used in both sections 251 and 253; it cannot be presumed that the term has two different meanings in these closely related statutes. Further, statutory interpretation is a 'holistic endeavor' that requires consideration of a statutory scheme in its entirety. . . . When the relevant statutory provisions are read together in light of the case law, it is apparent that the terms 'claims of the original patent' in section 251 unambiguously excludes the claims disclaimed pursuant to section 253.

Op. at 8.

The court also raised one policy consideration--notice to the public. The panel indicated that "under the approach to sections 251 and 253 urged by Vectra, however, a patentee would be able to reclaim previously disclaimed subject matter at any time during the term of the patent." Op. at 10. "Put another way, nothing would prevent the patentee from filing at any time a reissue application that reclaimed most of the disclaimed subject

matter because the patentee could never be said to be broadening the scope of the original claims." *Id.*

Based upon the reasoning above, the panel did not consider the Congressional intent underlying the "part of the original patent" language in the disclaimer statute, or the general purposes of the disclaimer and reissue statutes. As discussed below, this Court should grant this petition to resolve the issue of whether Congressional intent can be ignored where a statute is purportedly unambiguous, and, in particular, whether the lower courts should have considered the Congressional intent underlying the reissue and disclaimer statutes in construing the relationship of those statutes.

I. ARGUMENT

A. Summary of Argument

The lower courts erred because it ignored Congressional intent. Instead, it relied on a line of authority that suggests that where the statutory language is unambiguous, courts may rely on the "plain meaning" without any consideration of the underlying intent of Congress. A more recent line of authority holds that Congressional intent controls, even where such intent is inconsistent with the statutory language. Under this more recent line of authority, the language of the statute, although evidence of Congressional intent, is not dispositive.

The Court should use this opportunity to confirm that Congressional intent controls, at least where there is an ambiguity as to the relationship between two statutes. In the instant case, Congress did not intend that the filing of a disclaimer would invalidate otherwise valid claims. Congress created the disclaimer statute to allow patentees to preserve the validity of their patents and to encourage patentees to give notice to the public of claims known to be invalid. The lower court's decision is inconsistent with both of these Congressional purposes.

First, the decision is inconsistent with the Congressional intent that the disclaimer statute would be used to *preserve* the validity of patents. In fact, this is the first instance where the filing of a disclaimer has been held

to invalidate otherwise valid claims.

Second, the decision is inconsistent with the Congressional intent to encourage disclaimers. In fact, the decision will eliminate the use of disclaimers. Patentees will not disclaim invalid claims, and thus the public will not receive the benefits of notice that such claims are invalid, if such a disclaimer will limit patentees' future right to seek reissue.

The decision is also inconsistent with the specific purpose underlying the disclaimer statute's reference to a disclaimer being "part of the original patent." Congress provided that a disclaimer was "part of" the original patent to overcome the rule that any invalid claim of a patent invalidated the entire patent. The statute was intended to assist patentees preserve the validity of their patents. Congress never intended the "part of" language in the disclaimer statute to affect a patentee's right to obtain reissue under the reissue statute.

The decision is also inconsistent with the purpose of the reissue statute. The reissue statute provides a patentee may obtain claims narrower than those in the "original patent" at any time. There is nothing that suggests that Congress intended "original patent" to mean anything other than its ordinary and plain meaning. Although the Federal Circuit suggested that notice to the public could justify its statutory construction, that analysis does not withstand scrutiny. The Federal Circuit's decision has the anomalous result that a patentee is better off if its broad claims are invalidated in court, than if it voluntarily disclaims them.

In the former situation, a patentee may still seek reissue. No one can plausibly argue that Congress intended such a result, particularly when there is a clear Congressional intent to encourage the filing of disclaimers.

B. The Court Should Clarify the Role of Congressional Intent in Statutory Construction

The Court should grant this writ to clarify the purpose of Congressional intent in matters of statutory construction, particularly where the relationship between two statutes is involved. There are two conflicting lines of authorities concerning the role of Congressional intent. The Federal Circuit relied on authority suggesting that a court need not consider Congressional intent when the statutory language appears to be unambiguous. "Where the statute's language is plain 'the sole function of courts is to enforce it according to its terms.'" Op. at 6 (*quoting United States v. Ron Pair Enters., Inc.*, 489 U.S. 235, 241 (1989)) (quoting *Caminetti v. United States*, 242 U.S. 470, 485 (1917)); *see also United States v. Missouri Pac. Ry.*, 278 U.S. 269, 278 (1929) ("[W]here the language of an enactment is clear in construction and according to its terms does not lead to absurd or impractical consequences, the words employed are to be taken as the final expression of the meaning intended. . . ."); *Hemscheidt Corp. v. United States*, 72 F.3d 868, 871 (Fed. Cir. 1995) ("Language unmistakably certain on its face ends our inquiry."); *Hilliard v. United States*, 310 F.2d 631, 632 (6th Cir. 1962) ("We may not, under the guise of construction, find a Congressional intent that is contrary to the clear language employed by it. Where a statute is unambiguous, it should

be given effect according to its literal language."); *accord H.W. Wetter Mfg. Co. v. The United States*, 458 F.2d 1033, 1035 (6th Cir. 1972); *Resolution Trust Corp. v. Love*, 36 F.3d 972, 976 (10th Cir. 1994) ("If the language is clear and unambiguous, then the plain meaning of the words must be given effect.").

Another line of cases, however, holds that Congressional intent controls, even where it is contrary to the purported literal language of the statute:

> In the final analysis, any question of statutory construction requires the judge to decide how the legislature intended its enactment to apply to the case at hand. The language of the statute is usually sufficient to answer that question, but "the reports are full of cases" in which the will of the legislature is not reflected in a literal reading of the words it has chosen. In my opinion this is such a case.

Griffin v. Oceanic Constructors, Inc., 458 U.S. 564, 577 (1982) (J. Stevens, dissenting) (footnote omitted); *see also Heppner v. Alyeska Pipeline Service Co.*, 665 F.2d 868, 870 (9th Cir. 1981) ("[T]he plain meaning rule is no longer considered an absolute prohibition [of considering legislative intent], but a flexible principle for ascertaining the intent of Congress.") (disregarding literal language to find that statute was not intended to embrace certain claims); *Dole v. United Steelworkers of America*, 494 U.S. 26, 33 (1990); *N.L.R.B. v. United Food and Commercial Workers Union*, 44 U.S. 112, 123 (1987) ("On a pure

question of statutory construction, our first job is to try to determine the Congressional intent. . . . If we can do so, then that interpretation must be given effect.").

In the instant case, the panel made no attempt to ascertain the Congressional purpose underlying the disclaimer and reissue statutes. Had it done so, it would have been apparent that Congress never intended the disclaimer statute to be used in the manner to invalidate otherwise valid claims. Similarly, Congress never intend the reissue statute to be used in a manner that would essentially punish patentees who filed disclaimers, at least relative to patentees whose claims are invalidated in court.

C. Congress Intended the Disclaimer and Reissue Statute to Help Patentees Preserve the Validity of their Patents

Congress intended the disclaimer and reissue laws to allow a patentee to *preserve* the validity of a patent. Both statutes appear in a chapter entitled "Amendment and Correction of Patents." Neither the legislative history nor the case law supports the Federal Circuit's conclusion that Congress intended infringers to invalidate subsequent reissue claims on the basis of an earlier disclaimer. In fact, the instant case is the first time that the filing of a disclaimer has ever been held to invalidate an otherwise valid claim.

There is no dispute that Congress created disclaimers to (1) allow patentees to preserve the validity of their patents; and (2) to encourage patentees to inform the

public of patent claims they will not enforce. For more than 100 years, the Supreme Court has held that the disclaimer statutes are intended to help patentees preserve their patents. *See Hailles v. Albany Stove Co.*, 123 U.S. 582, 589 (1887) ("[The disclaimer statutes] are parts of one law, having one general purpose; and that purpose is to obviate the inconvenience and hardship of the common law, which made a patent wholly void if any part of the invention was wrongfully claimed by the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it."); *Marconi Wireless Tel. Co. v. United States*, 320 U.S. 1, 58, 57 U.S.P.Q. 471, 472-73 (1943) ("[T]he purpose of disclaimer statute is to enable patentee to relieve self from consequences of making invalid claim. . . ."); *Altoona Publix Theaters, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 490 n.3, 24 U.S.P.Q. at 314 n.2 (1935) ("The disclaimer . . . statutes were adopted to avoid the rule that if one claim is invalid the whole patent is void.").

As explained by P.J. Federico in his classic "Commentary on the New Patent Act":

> The theory of disclaimers under the old statute was based upon an implied common law rule that if a patent was invalid in part it was invalid in whole, that is, if any one claim of a patent was invalid the entire patent fell. In order to save the patent then, the disclaimer statute (first enacted in 1837 [act March 3, 1837, c.45, 5 STAT. 191]) provided in effect that if the invalid part (claim) were disclaimed without

> unreasonable neglect or delay, suit could be maintained upon any other part (claim) which might be valid.

To make the disclaimer effective, so as to save the patent, the courts engaged in the legal fiction that the disclaimer dated back to the original patent. In this manner, the patent could be enforced because the invalid claim never existed.

The reissue statute was also intended to assist patentees preserve the validity of their patents. In 1952, a variety of amendments were made to the Patent Act. The amendments included changes to the law concerning reissue, correction and disclaimer. All of such changes were intended to assist the patentee maintain the validity of his or her patent:

> Furthermore, the 1952 Act liberalized the law there set forth in several particulars with respect to reissue, correction, and particularly disclaimer. . . . It might also be mentioned as an indication of a liberal trend on the part of the legislature that § 255 permitting applicants to correct certain errors was entirely new, that § 251 made it explicit that reissue could be had if the patentee claimed *less* than he was entitled to. . . . Also the law invalidating an entire patent for failure promptly to disclaim a claim known to be invalid was done away with. . . . All of this is the antithesis of a public policy preventing the correction of mistakes, including mistakes in issued patents.

In re Hession, 296 F.2d 930, 953, 132 U.S.P.Q. 40, 59 (C.C.P.A. 1961) (Rich, J., dissenting) (emphasis in original).

The reissue statute was amended to provide that a patentee could obtain claims narrower than those in the "original patent" at any time. 35 U.S.C. § 251. Although the 1952 amendments retained the "date back" language for disclaimers (*i.e.*, that a disclaimer, after according, was "part of the original patent"), there is no indication that the rule was intended to apply to the meaning of "original patent" in the reissue statute. The original (and only) purpose of the "part of the original patent" language was to avoid invalidating a patent. There was never an intent that the rule be applied to invalidate reissue claims.

There is no genuine dispute as to the purpose of the disclaimer statute. Nevertheless, in contravention of this Congressional purpose, the lower courts held the disclaimer statute can be used by an infringer to *invalidate* patent claims otherwise properly issued by the PTO. Neither the legislative history nor the case law suggests that Congress intended the disclaimer statute to operate in this manner.

The Federal Circuit ignored the Congressional purpose underlying the disclaimer and reissue statutes. Instead, the court indicated that it was bound by the "plain meaning" of the disclaimer statute. In reaching this result, however, the court ignored the "plain meaning" of "original patent" in the reissue statute. More importantly, if the court had considered the purpose of the disclaimer statute, and the specific purpose of the "part of the original patent"

language, it would have realized that its decision is contrary to the specific purpose of that language.

D. The Federal Circuit's Decision Undermines Congress' Intent to Encourage Disclaimers

The Federal Circuit not only ignored the Congressional purpose underlying the disclaimer and reissue statutes, but also Congressional intent to encourage disclaimers because they provide notice to the public that a patentee will not attempt to enforce certain patent claims. *See* 35 U.S.C. § 288 (providing that a patentee is unable to recover costs unless it has disclaimed any invalid claims in the patent). This Court has long recognized the public interest in a patentee promptly disclosing that certain claims are invalid. This public policy "rests upon the . . . principle that misuse of the patent, or a part of it, by the patentee in such a manner as to mislead the public . . . deprives the claim of the benefit of the patent laws." *Altoona Publix Theaters, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 493 (1935) (interpreting earlier statute that provided that unreasonable delay in making disclaimer invalidated entire patent); *see also O'Reilly v. Morse*, 15 How. 61, 121 (1853) (considering issue of whether entire patent was invalid because patentee had unreasonably delayed submitting disclaimer).

The panel's decision is contrary to that intent. In fact, the panel's decision is the death knell for disclaimers because, according to the panel, a patentee is forever limited from seeking what would otherwise be a narrowing reissue. Patentees will never file disclaimers if it will

prejudice their ability to seek what would subsequently be a valid reissue. The Congressional purpose of the disclaimer statute, and thus its benefit to the public (*i.e.*, providing notice), are defeated by the panel's interpretation.

E. The Panel Also Ignored Congressional Intent Regarding the Reissue Statute

The Federal Circuit's decision also ignores the literal language of the reissue statute and the Congressional intent underlying the statute. Congress provided that patentees may, at any time, obtain reissue claims narrower than those in the "original patent." The ordinary and plain meaning of "original patent" means the patent that originally issued. That interpretation is straightforward and is consistent with the Congressional purpose underlying the reissue statute, which was to provide a "bright line" rule, as opposed to the prior unreasonable delay/laches approach to broadening reissues. Under the current rule, the public knows that it can look at the original patent and that, unless applied for within two years, no claims broader than those in the original patent will be allowed. The rule is straightforward and provides the public with the notice that Congress desired. There is nothing in the legislative history or case law suggesting that Congress intended the meaning of "original patent" to be affected by the filing of a disclaimer. In fact, the purposes of the reissue and disclaimer statutes suggest the opposite.

F. The Panel's Concern About "Recapture" Makes No Sense

Instead of relying on Congressional intent, the Federal Circuit contrived a policy justification for its decision. The panel held that a patentee should not be able to "recapture" subject matter previously disclaimed. If it could do so, the panel concluded, "the public would have to avoid almost the entire scope of the claims as originally filed because, at any time, a patentee could file a reissue application that included a claim recapturing most of the subject matter previously disclaimed." *Op.* at 10-11. There is no legislative history or case law suggesting that Congress shared the panel's concern. In fact, the language of the reissue statute suggests the opposite. The reissue statute allows a patentee to obtain reissue claims narrower than those in the "original patent" at any time. Such reissue claims are permissible, even if the broad claims of the original patent have been invalidated in court. In other words, a patentee may "recapture" the subject matter of previously invalidated claims.

According to the logic of the panel's decision, Congress intended to allow patentees whose claims are invalidated to recapture such subject matter, but intended to preclude patentees who voluntarily disclaim such claims. There is no conceivable reason why Congress would have intended to confer greater benefits on those whose claims are invalidated as opposed to those who do the public a service by voluntarily disclaiming invalid claims. The panel cannot reasonably believe that Congress would have intended to create such a distinction.

There are two other reasons why the panel's reasoning fails. First, although the panel is concerned about public reliance on disclaimers, the public will never realize the benefits of disclaimer, under the panel's interpretation. Because a patentee will not disclaim any claim that affects its ability to obtain reissue claims (even if the claim is believed invalid), the public is forced to rely on *the entire scope* of the claims as originally issued in making a determination of how to avoid infringement. This is counter to the public policy on which the panel's decision so heavily relies.

Second, Congress has already addressed the issue of protecting the public from broader reissue claims. The doctrine of "intervening rights," codified in 35 U.S.C. § 252, recognizes the rights of someone who has manufactured, used, offered for sale, or sold prior to the grant of broader reissue patent claims. Given that Congress has already addressed this issue, there is no basis for the Federal Circuit's conclusion concerning protection of the public.

G. The Panel's Strict Literalism Advances No Congressional Intent or Policy and Leads to Absurd Results

The panel's strict literalism advances no Congressional intent or public policy and, if logically carried out, leads to absurd results. First, the decision does not promote the general purpose of the patent laws to allow a patentee to protect a patentable invention. Instead, the decision allows the invalidation of an otherwise valid patent on the most technical of all grounds. Second,

the decision does not advance the Congressional purpose allowing disclaimers to be used to preserve a patent's validity; it does the opposite (*i.e.*, it allows an infringer to file a disclaimer to invalidate an otherwise valid claim). Third, the decision does not promote Congress' intent to encourage the filing of disclaimers; it does the opposite. The decision spells the death of disclaimers, for no patentee will file a disclaimer if it will forever limit the patentee's attempt to otherwise obtain reissue claims. Thus, the public will get *less* notice, not more notice, as to what claims could be reissued in the future.

Finally, the panel's strict literalism interpretation, if logically extended, leads to absurd results. According to the panel's decision, a reissue claim is valid if the broad original claims are invalidated in court or *canceled* as part of a reissue application, but is invalid if the claims are *disclaimed* before, during or even after the reissue application is filed. Similarly, if the filing of a disclaimer means that the original patent never included the disclaimed claims, how does this affect inequitable conduct in the procurement of the claims? Such an inequitable conduct generally renders the patent unenforceable in its entirety. If inequitable conduct has been committed with respect to certain broad claims, however, could the filing of a disclaimer cure such inequitable conduct because those claims never existed? Congress never intended such results.

The panel also suggests that it must interpret the term "original patent" in the two statutes in the same way. First, there is no reason why words in different statutes cannot have different meanings:

> The tendency to assume that a word which appears in two or more legal rules, and so in connection with more than one purpose, has and should have precisely the same scope in all of them, runs all though legal discussions. It has all the tenacity of original sin and must constantly be guarded against.

Walter W. Cook, *Substance and Procedure in the Conflict of Laws*, 42 Yale L.J. 333, 337 (1937).

In the instant case, "original patent" has very different purposes in the reissue statute and the disclaimer statute.

Second, the Federal Circuit did not, in a logical sense, interpret the terms "original patent" consistently between the two statutes. In the disclaimer statute, the panel interprets the term "original patent" as including the original claims. Otherwise, a disclaimer makes no sense. In the reissue statute, the panel interprets "original patent" as not including all the original claims. The issue is not whether "original patent" is being interpreted in the same manner, but how "part of the original statute" in the disclaimer statute should be construed consistent with Congressional intent.

Even if the issue were whether "original patent" should have the same definition in both statutes, terms can have different meanings in "closely related statutes." Op. at 8. In fact, when necessary to effect Congressional intent, courts have held that a term may have two different meanings within the *same* statute. *See Common Cause v. Federal Election Commission*, 842 F.2d 436, 442 (D.C. Cir. 1988) ("[T]he assertion that these two sections must be similarly construed ignores the different purposes served by each section. . . .")

H. The Panel Ignored the Purpose of Requiring Recording in the Disclaimer Statute

The panel also held that the disclaimer was "recorded" even if it was not publicly accessible (*i.e.*, even if it had not been provided in the file). The panel's reasoning is that because the *requirements* for recording were satisfied (*i.e.*, the disclaimer was filed in proper form), the "recording" automatically followed. Again, this logic fails. If Congress had intended "recording" to be equivalent to "filing," it could have said so. Congress believed that filing and recording were separate activities. The Senate Report states that the "patentee files a [disclaimer] in the Office which is recorded." *Allen Archery, Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 1096 (Fed. Cir. 1987) (discussing legislative history of disclaimer statutes). Filing and recording are thus different events.

Further, the purpose of recording disclaimers suggests public notice. The panel makes reference to the public being entitled to rely upon the "public record" of a disclaimer. Slip Op. at 9. This is consistent with the purpose of a disclaimer, which is to provide notice to the public. This is also evident from the rules of the PTO, which require that the disclaimer be published in the Official Gazette and that copies of the disclaimer be attached to the patent. There is no evidence that the disclaimer in the instant case was published, attached to any printed copies of the patent, or even put into the '972 patent file prior to the filing of the reissue application. The disclaimer was not recorded on the face of the '972 file wrapper cover sheet or on its contents page. Because there was no public record of the disclaimer, the disclaimer was not "recorded" within the meaning of the term in § 253.

II. CONCLUSION

For the reasons set forth above, the Court should grant Vectra's petition.

Respectfully submitted,

SEED AND BERRY LLP

/S/ Richard W. Seed
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(206) 622-4900

Attorneys for Petitioner
Appellant Vectra Fitness, Inc.

ADDENDUM

The Honorable Carolyn R. Dimmick

FILED ENTERED
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AT SEATTLE
CLERK U.S. DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
BY DEPUTY

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

VECTRA FITNESS, INC., a Washington corporation, Plaintiff, v. PACIFIC FITNESS CORP., a California corporation, Defendant.	Civil Action No. No. C96-1892D [PROPOSED] ORDER AMENDING PARTIAL SUMMARY JUDGMENT OF OCTOBER 3, 1997, PURSUANT TO 28 U.S.C. § 1292(b) AND STAYING ACTION

Plaintiff Vectra Fitness, Inc. has moved for the Court to amend its Summary Judgment Order of October 3, 1997, to include certain statements required by 28 U.S.C. § 1292(b) necessary for a petition for permission to appeal. Defendant does not oppose such relief. The Court having considered the argument of counsel and being fully apprised of the issues,

[PROPOSED] ORDER AMENDING PARTIAL SUMMARY JUDGMENT OF OCTOBER 3, 1997, PURSUANT TO 28 U.S.C. § 1292(b) AND STAYING ACTION 1

IT IS HEREBY ORDERED that the Court's ~~partial~~ order granting defendant's motion for partial summary judgment, dated October 3, 1997, is amended to include the following language:

(1) This Order involves a controlling question as to which there is substantial ground for a difference of opinion: whether the rule that disclaimers date back to the original patent issuance should apply for purposes of determining whether a subsequent reissue impermissibly broadens the scope of the patent. The Court believes this presents a narrow issue of first impression;

(2) An immediate appeal from this Order may materially advance the ultimate termination of this litigation;

(3) This amendment shall be deemed entered as of this date for purposes of computing the time for filing a petition for permission to appeal; and

(4) Pending the appellate court's determination of whether to accept the appeal and, if the appeal is accepted, pending a final determination on appeal, this action, including all discovery, is hereby stayed.

DATED this 2 December day of November, 1997.

United States District Judge

Presented by:

SEED AND BERRY LLP

Ramsey M. Al-Salam, WSBA #18822
701 Fifth Avenue, Suite 6300
Seattle, Washington 98104
Telephone: (206) 622-4900

Attorney for Plaintiff
Vectra Fitness Corporation

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A003

(PROPOSED) ORDER AMENDING PARTIAL SUMMARY JUDGMENT OF OCTOBER 2, 1997, PURSUANT TO 28 U.S.C. § 1292(b) AND STAYING ACTION 3

FILED
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OCT 03 1997

AT SEATTLE
CLERK U.S. DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
BY
DEPUTY

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

VECTRA FITNESS, INC.,	)	
	)	
Plaintiff,	)	No. C96-1892
	)	
v.	)	ORDER GRANTING
	)	DEFENDANT'S
PACIFIC FITNESS CORP.,	)	MOTION FOR
	)	PARTIAL SUMMARY
Defendant.	)	JUDGMENT
	)	

THIS MATTER comes before the Court on defendant's motion for partial summary judgment declaring three of plaintiff's patent claims invalid. Having reviewed the motion and all supporting and opposing memoranda and

documents, the Court hereby grants partial summary judgment.

This motion presents a narrow issue of first impression: whether the rule that disclaimers date back to the original patent issuance should apply for purposes of determining whether a subsequent reissue on the same patent impermissibly broadens the scope of the patent. The Court finds that it should.

FACTS

This case involves plaintiff's patent on its multi-station exercise machine. Plaintiff acquired its original patent, No. 4,809,972, containing twenty-seven claims, on March 7, 1989. Learning of prior art that might make some claims invalid, it filed a disclaimer of seven claims on February 20, 1990. Upon reconsideration, it decided that portions of the disclaimed claims should be reinstated, and filed for a reissue which included three new claims, numbered 28-30, on May 9, 1991. This was granted as No. Re. 34,572.

Vectra sued Pacific in December 1996, alleging infringement of several of its claims, including one of the newer claims.

The parties agree on the pertinent facts regarding the nature of the various claims involved. They agree that plaintiff's disclaimer narrowed its original patent and that the new claims on reissue restore some, but not all, of that breadth, thus broadening the post-disclaimer patent. Therefore, if the reissue is compared to the original, it does not broaden the claims, but if compared to the post-disclaimer patent, it does broaden the claims.

DISCUSSION

Patents are presumed valid, and may only be proved invalid by clear and convincing evidence. *Ralston Purina Co. v. Far-Mar-Co.*, 772 F.2d 1570, 1574 (Fed. Cir. 1985). Summary judgment is appropriate where there are no genuine issues of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250 (1986). In ruling on a motion for summary judgment, a court must assume that the

facts alleged by the non-movant are true and draw all reasonable inferences therefrom. *See Anderson* at 255. The Court finds defendant has presented clear and convincing evidence that claims 28-30 are invalid as a matter of law, and plaintiff fails to show a genuine issue of material fact exists.

The issue presented falls between two provisions of the patent code. On the one hand, reissued patents that broaden the scope of originals may be granted only if applied for within two years of the original grant. 35 U.S.C. § 251. Meanwhile, disclaimers have the effect of altering the terms of the original patent. 35 U.S.C. § 253. "A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent." *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996), *cert. denied*, 117 S. Ct. 1692 (1997) (citing *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 491 (1935)). Thus, reading these two provisions in tandem, as defendant asks the Court to do, indicates that since plaintiff narrowed its

original patent through disclaimer, then attempted to broaden the scope of the resulting claims more than two years after issuance, the reissue is invalid and defendant's motion should be granted.

Plaintiff makes a number of arguments urging the Court to avoid this result, using a number of approaches to the disclaimer and reissue problem, including: the disclaimer was ineffective and thus the reissue did not enlarge the original claims; the disclaimer was effective but does not alter the original claims for purposes of reissue; or the disclaimer started the clock anew on broadening the claims. None of these approaches is satisfactory.

First, plaintiff calls defendant's insistence on "dating back" the disclaimer a "novel rule," and distinguishes each case cited by defendant for the disclaimer and reissue rules. Of course, this is possible because no case has tackled the precise problem presented by this case. The cases support the separate application of the disclaimer rule (disclaimers alter a patent from its original issue date) and the reissue rule (a

patentee may not enlarge a patent more than two years after its issue date), and therefore support, but do not command, the result urged by defendant.

Second, plaintiff claims that application of the two rules would require plaintiff to refrain from the "selfless and commendable act" of disclaimer until after it sought a reissue. Docket No. 18 at 5, 6. This is not true. Simultaneous operation of the two rules only requires plaintiff to have filed its application for reissue within two years of the original patent issuance. In this case, plaintiff disclaimed less than a year after issue and therefore had over a year remaining to apply for reissue.[1]

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[1] In fact, there appears no reason why plaintiff could not have consolidated its actions (dropping several claims and substituting three new ones) into one reissue application. In that case, plaintiff is correct that it would have had to formulate its reissue application before disclaiming the invalid claims, thus perhaps discouraging prompt disclaimer. However, the disclaimer statute long ago dropped the requirement of promptness, and the only sanction for *never* disclaiming invalid claims is losing the right to recover costs. *Allen Archery, Inc. v. Jennings Compound Bow, Inc.*, 686 F.2d 780, 782, 783 (9th Cir. 1982). Thus, we are left without an explanation for plaintiff's quick disclaimer and belated reissue application.

Third, plaintiff argues that dating back the disclaimer for reissue purposes does not advance the purposes of the disclaimer statute. Plaintiff notes that originally, an invalid claim would make the entire patent invalid, and that dating back of disclaimers was intended to prevent this result. *See Altoona Publix Theatres, Inc v. American Tri-Ergon Corp.*, 294 U.S. 477, 490 n. 2 (1935). Since invalid claims no longer render an entire patent void, *see Allen Archery, Inc. v. Jennings Compound Bow, Inc.*, 686 F.2d 780, 783 (9th Cir. 1982), dating back disclaimers is not necessary. Conceding this to be the case does not help plaintiff, because the statute has not been amended. Defendant is correct that this argument should be made to Congress, not the courts.

Moreover, if the Court were to alter the disclaimer rule in this case, it would be left without a comprehensible statutory scheme. The reissue statute forbids alterations that enlarge the scope *of the original* to occur later than two years *from the grant of the original* patent. 35 U.S.C. § 251. The parties agree that this limitation is intended to allow the

public to rely upon the published scope of a patent after a reasonable period, without fear of infringement by virtue of later amendments. In order to hold plaintiff's reissue claims valid, the Court must find that the disclaimer did not alter the "original" within the meaning of the reissue statute. The result would be that claims 28-30, which concededly enlarge the post-disclaimer patent, would never be barred, since they would never enlarge the original, since the "original" is unaffected by the disclaimer.[2] This would contravene the purpose behind the time limit in § 251.

Finally plaintiff argues that the disclaimer did not take effect at all, since the Patent and Trademark Office ("PTO") did not "publish" the disclaimer or notify plaintiff of its receipt. Plaintiff claims the statute, which says "disclaimer[s] shall be in writing, and recorded in the Patent and Trademark Office," 35 U.S.C. § 253, requires publication of some kind.

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[2] An alternative reading, alluded to by plaintiffs, would be to measure the two-year window for reissue from the date of disclaimer. But this is clearly not what the statute says, and would therefore amount to substituting the Court's words for those of Congress.

Plaintiff also notes that the purpose of the time limit on reissue is to provide notice to the public, and says that since the public never had notice of the disclaimers, it will not be harmed by the reissue. Plaintiff cites no law in support of its argument. Current records of the PTO clearly contain the disclaimer, as filed February 20. Thus, it seems obvious that the disclaimer was "in writing, and recorded" in some fashion. Moreover, in its reissue application more than one year after disclaimer, plaintiff attempted to proceed as if the disclaimer had not occurred, and was rebuked by the PTO, which said the disclaimers of February 20 barred the amendments plaintiff proposed. Thus, there is virtually no way to say the PTO did not "record" the disclaimer as required.

CONCLUSIONS

The law is clear on disclaimers, which are effective from the date of the original patent, and reissues, which cannot be obtained more than two years after issue of the original if they propose to enlarge its scope. Unpersuaded

that an exception should or can be made to fit this case, the Court hereby GRANTS defendant's motion for partial summary judgment, finding defendant's patent claims 28-30 invalid.

The Clerk of the Court is directed to send copies of this order to all counsel of record.

DATED this 3rd day of October, 1997.

Carolyn R. Dimmick
United States District Judge

lit:\vec804\order granting

Judgment

ON APPEAL from the UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF WASHINGTON

in CASE NO(S). 96-CV-1892

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED: **AFFIRMED**.

ENTERED BY ORDER OF THE COURT

DATED _____ Jan Horbaly
Jan Horbaly, Clerk

A True Copy.

Attest: 1/29/99

ISSUED AS A MANDATE:
JANUARY 29, 1999

A.M. Tomlinson
Deputy Clerk

DECIDED: December 14, 1998

Before PLAGER, RADER, and SCHALL, Circuit Judges.

SCHALL, Circuit Judge.

Vectra Fitness, Inc. (Vectra) appeals a partial summary judgment of the United States District Court for the Western District of Washington invalidating claims added to Vectra's U.S. Patent No. 4,809,972 (the '972 patent) in reissue proceedings. Vectra Fitness, Inc. v. Pacific Fitness Corp., No. C96-1892D (W.D. Wash. Oct. 3, 1997). The district court held that the invalidated claims--which were narrower than the claims originally contained in the '972 patent, but broader than the claims remaining in the patent after a disclaimer--impermissibly enlarged the scope of the claims of the original patent more than two years after the grant of the original patent, in violation of 35 U.S.C. § 251.[1] We have jurisdiction over the appeal pursuant to 28 U.S.C. § 1292(c)(1). We affirm.

BACKGROUND

I.

On March 7, 1989, the '972 patent, entitled "Exercise Machine with Multiple Exercise Stations,

[1] All statutory references are to the 1994 version of the United States Code.

was issued to Vectra as assignee. The '972 patent related to multi-station exercise machines that allow two or more exercise stations to be connected to a single weight stack.

As issued, the '972 patent contained 27 claims. On February 16, 1990, Vectra submitted a disclaimer to the United States Patent and Trademark Office (PTO), in accordance with 35 U.S.C. § 253. The disclaimer canceled Claims 1, 2, 3, 4, 13, 20, 21, and 24. These were the broadest claims of the '972 patent. Vectra submitted the disclaimer when it became aware that the eight claims were invalid based on previously unknown prior art. After the disclaimer was received, it was mishandled by the PTO. Although the disclaimer was added to the file wrapper of the '972 patent, it was not entered on either the cover page or the contents page of the wrapper. In addition, the PTO failed to publish the disclaimer in the Official Gazette, as contemplated by PTO regulations. See 37 C.F.R. § 1.321(a) (1990) ("A notice of the disclaimer is published in the Official Gazette . . . .").

On May 9, 1991, Vectra filed a reissue application that sought to add new claims 28-30 to the '972 patent. The reissue application, including new claims 28-30, was issued on March 29, 1994, as U.S. Patent No. Re 34,572 (the '572 patent). Before the district court, the parties stipulated that claims 28-30 were narrower in scope than the claims originally contained in the '972 patent, but broader in scope than the claims remaining the patent after the 1990 disclaimer.

II.

Vectra sued TNWK Corporation (TNWK) (formerly known as Pacific Fitness Corporation) for infringement of the '572 patent on December 4, 1996. In due course, TNWK moved for partial summary judgment. It did so on the ground that claims 28-30 were invalid under 35 U.S.C. § 251 because they impermissibly enlarged the scope of the '972 patent more than two years after the date of its original issue. On October 3, 1997, the district court granted TNWK's motion, holding that the 1990 disclaimer was effective from (i.e., "dated back" to) March 7, 1989, the date of the original patent, and that therefore the reissue claims were broader than the claims of the "original patent." In so holding, the district court rejected Vectra's argument that the disclaimer never took effect because the PTO failed to publish it. The court stated that since current records of the PTO contained the disclaimer as filed February 20, 1990, "it seems obvious that the disclaimer was 'in writing and recorded' in some fashion." The court concluded, "There is virtually no way to say the PTO did not 'record' the disclaimer as required."

Vectra timely moved to certify the case for interlocutory appeal pursuant to 28 U.S.C. § 1292(b), and the district court granted the motion. On January 22, 1998, this court granted Vectra's petition for permission to appeal. See Vectra Fitness, Inc. v. Pacific Fitness Corp., 135 F.3d 777 (Fed. Cir. 1998) (Table). Currently, proceedings in the district court are stayed.

DISCUSSION

We review a district court's grant of summary judgment de novo. See Astra v. Lehman, 71 F.3d 1578, 1580, 37 USPQ2d 1212, 1214 (Fed. Cir. 1995); Glaxo Operations UK Ltd. v. Quigg, 894 F.2d 392, 395, 13 USPQ2d 1628, 1630 (Fed. Cir. 1990). If, as in this case, no genuine issues of material fact are present, we need only decide whether the decision by the district court is correct as a matter of law. See Armco, Inc. v. Cyclops Corp., 791 F.2d 147, 149, 229 USPQ 721, 723 (Fed. Cir. 1986). This case presents a narrow issue of first impression: whether a reissue application filed more than two years after the grant of the original patent is bounded by the claims originally contained in the patent or by the claims remaining in the patent after a disclaimer is filed. This issue of statutory interpretation is a question of law, which we review de novo. See In re Chu, 66 F.3d 292, 296, 36 USPQ2d 1089, 1092-93 (Fed. Cir. 1995).

As a preliminary matter, Vectra argues that the mishandling of the disclaimer by the PTO prevented it from being "recorded" within the meaning of that term in 35 U.S.C. § 253. See 35 U.S.C. § 253 ("Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered part of the original patent . . . ."). Accordingly, so the argument goes, the purported disclaimer had no effect. We disagree.

The recording of a disclaimer is not dependent upon actions taken by the PTO. The pertinent PTO rule provides as follows:

> The disclaimer, to be recorded in the Patent and Trademark Office, must:
>
> (1) Be signed by the patentee, or an attorney or agent of record;
>
> (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
>
> (3) State the present extent of patentee's ownership interest in the patent; and
>
> (4) Be accompanied by the fee set forth in § 1.20(d).

37 C.F.R. § 1.321(a) (1997); see also Manual of Patent Examining Procedure (MPEP) § 317.01 (6th ed. Rev. 3 1997) (setting the date of recording of an assignment, which is analogous to recording a disclaimer, as the date on which the assignment is received by the PTO "in proper form and with the full filing fee"). The language of the regulation was slightly different when the disclaimer at issue in this case was filed, in that the regulation in 1990

did not specifically refer to recording.[2] However, both the current regulation and the regulation in 1990 set forth the requirements for a valid disclaimer and therefore the requirements for the recording of the disclaimer. Moreover, nothing the statutes or regulations requires any action by the PTO for a disclaimer to be "recorded." There is no dispute that Vectra's disclaimer was received by the PTO in proper form and with the appropriate filing fee on February 20, 1990. Accordingly, the disclaimer was recorded on that date regardless of its handling by the PTO.

Turning to the matter of the disclaimer and the reissue, we begin our analysis with the language of the statute. See Zenith Elec. Corp. v. United States, 77 F.3d 426, 430 (Fed. Cir. 1996). Where "the statute's language is plain, 'the sole function of the courts is to enforce it according to its terms.'" United States v. Ron Pair Enters., Inc., 489 U.S. 235. 241, 109 S. Ct. 1026, 1030, 103 L. Ed. 2d 290 (1989) (quoting Caminetti v. United States, 242 U.S. 470, 485, 37 S. Ct. 192,194, 61 L. Ed. 442 (1917)).

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[2] As in effect in 1990, the regulation provided as follows:

> A disclaimer under 35 U.S.C. § 253 must be accompanied by the fee set forth in § 1.20(d) and identify the patent and the claim or claims which are disclaimed, and be signed by the person making the disclaimer, who shall state therein the extent of his or her interest in the patent.

37 C.F.R. § 1.321(a) (1990).

The reissue of patents is governed by 35 U.S.C. § 251, which provides in pertinent part: "No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent." (Emphasis added.) Disclaimers are governed by 35 U.S.C. § 253, which provides as follows:

> Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.
>
> In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

(Emphasis added.)

Section 251 prohibits the addition of claims that broaden the scope of the claims of the original patent more than two years after the grant of the patent. See 35 U.S.C. § 251. As noted above, the parties agree that claims 28-30 were broader than the claims remaining after the 1990 disclaimer, but narrower than the disclaimed claims. Accordingly, the validity of claims 28-30 depends upon whether or not the disclaimed claims are considered part of the "original patent," as that term is used in section 251. If the disclaimed claims are considered part of the "original patent," claims 28-30 did not broaden the scope of the patent more than two years after its grant in contravention of section 251. If the disclaimed claims are not considered part of the "original patent," however, claims 28-30 did broaden the scope of the patent more than two years after its grant and therefore did contravene section 251.

Vectra argues that the plain meaning of the term "claims of the original patent" in 35 U.S.C. § 251 refers to the claims contained in the patent when it issued, unaffected by any disclaimer pursuant to 35 U.S.C. § 253. TNWK counters that the plain language of 35 U.S.C. § 253 and the pertinent case law indicates that a disclaimer becomes a part of the original patent and that the disclaimed claims are viewed as if they never existed. TNWK asserts that, by filing a disclaimer, Vectra effectively modified the original patent to exclude the disclaimed claims and that any reissue application that enlarged the scope of the non-disclaimed claims must have been applied for within two years of the grant of the original patent. We agree with TNWK.

This court has interpreted the term "considered as part of the original patent" in section 253 to mean that the patent is treated as though the disclaimed claims never existed. See Guinn v. Kopf, 96 F.3d 1419, 1422, 40 USPQ2d 1157, 1160 (Fed. Cir. 1996) ("A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent."); see also Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U.S. 477, 492, 55 S. Ct. 455, 461, 79 L. Ed. 1005 (1935) ("Upon the filing of the disclaimers, . . . the public was entitled to manufacture and use the device originally claimed as freely as though [the claim] had been abandoned."). Consequently, when Vectra invoked section 253 and disclaimed the broadest claims in the '972 patent, it effectively eliminated those claims from the original patent.

Vectra does not contest that the disclaimer effectively eliminated the disclaimed claims from the "original patent" within the meaning of that term in section 253. Vectra asserts, however, that section 253 has nothing to do with the interpretation of the term "original patent" in section 251. In other words, Vectra argues that the original patent excludes the disclaimed claims under section 253, but includes the disclaimed claims for purposes of section 251. We disagree. The term "original patent" is used in both sections 251 and 253; it cannot be presumed that the term has two different meanings in these closely related statutes. See United Sav. Ass'n v. Timbers of Inwood

98 L. Ed. 2d 740 (1988) (stating that the same term used in a related statute clarifies the meaning of the term). Further, statutory interpretation is a "holistic endeavor" that requires consideration of a statutory scheme in its entirety. Id. at 371, 108 S. Ct. at 630 ("A provision that may seem ambiguous in isolation is often clarified by the remainder of the statutory scheme--because the same terminology is used elsewhere in a context that makes its meaning clear . . . ."). When the relevant statutory provisions are read together in light of the case law, it is apparent that the term "claims of the original patent" in section 251 unambiguously excludes the claims disclaimed pursuant to section 253.

No previous decision of our court has considered the application of the date back rule of section 253 (i.e., the provision providing that a disclaimer becomes part of the original patent) to reissue applications. However, the date back rule has been applied beyond the confines of a section 253 analysis. In In re Hyman, 185 USPQ 441 (Pat. Off. Sol. 1975), the Patent and Trademark Office Solicitor (Solicitor) applied the date back rule in determining whether a certificate of correction was required to correct claims previously disclaimed. Hyman had disclaimed Claims 24, 30, and 67 of U.S. Patent No. 3,705,938, pursuant to 35 U.S.C. § 253. See Hyman, 185 USPQ at 442. Subsequently, he submitted a request under 35 U.S.C. § 255 for a certificate of correction to cancel the same claims. See id. Hyman sought theapparently redundant certificate of correction because it would date back to the date of the original patent. See id. Section 255 provides

that a certificate of correction "shall have the same effect . . . as if the [patent] had been originally issued in such corrected form." 35 U.S.C. § 255. The Solicitor held that the certificate of correction was superfluous because the disclaimer, like the certificate of correction, relates back to the original date of the patent. See Hyman, 185 USPQ at 442.

In sum, we conclude that the reading of sections 251 and 253 that is urged by Vectra--that in the wake of a disclaimer, subsequent reissue claims are bounded by the claims as originally filed prior to the disclaimer--is contrary to the plain language of the statutes and pertinent case law. Moreover, an additional consideration also weighs against the interpretation of the statutory scheme for which Vectra argues.

The public is entitled to rely upon the public record of a patent in determining the scope of the patent's claims. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996). This reliance enables businesses, as well as others, to plan their future conduct in as certain an environment as possible. See id.; see also Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1424, 44 USPQ2d 1103, 1107 (Fed. Cir. 1997) (discussing the public-notice function of claims in the context of a doctrine of equivalence analysis). For example, the "recapture rule" prevents a patentee from regaining through reissue subject matter surrendered during prosecution, thus ensuring the ability of the public to rely on a patent's public record. See In re Clement, 131 F.3d

1464,1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997).

In a similar vein, after the two-year window for broadening reissues, the public should be able to rely on the scope of non-disclaimed claims. Cf. Wollensak v. Reiher, 115 U.S. 96, 100, 5 S. Ct. 1137, 1139, 29 L. Ed. 350 (1885) (discussing the rule of laches as applied to broadening reissues and stating that, "no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent"). Under the approach to sections 251 and 253 urged by Vectra, however, a patentee would be able to reclaim previously disclaimed subject matter at any time during the term of the patent. Put another way, nothing would prevent the patentee from filing at any time a reissue application that reclaimed most of the disclaimed subject matter because the patentee could never be said to be broadening the scope of the original claims. This partial recapture would effectively render disclaimers a nullity. The public could never rely on the scope of the non-disclaimed claims. To be safe from allegations of infringement, the public would have to avoid almost the entire scope of the claims as originally filed because, at any time, a patentee could file a reissue application that included a claim recapturing most of the subject matter previously disclaimed. In short, allowing Vectra to later recapture some of the subject matter that was explicitly disclaimed would negate the finality and certainty of the disclaimer. We believe that it would be contrary to established principles of statutory interpretation to adopt a

reading of 35 U.S.C. §253 that yielded such a result. See Griffin v. Oceanic Contractors, Inc., 458 U.S. 564, 575, 102 S. Ct. 3245, 3252, 73 L. Ed. 2d 973 (1982) ("[I]nterpretations of a statute which would produce absurd results are to be avoided if alternative interpretations consistent with the legislative purpose are available.").

CONCLUSION

For the foregoing reasons, the judgment of the district court is affirmed.

AFFIRMED

United States Court of Appeals for the Federal Circuit

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be and the same hereby is, DECLINED.

The mandate of the court will issue on January 29, 1999.

FOR THE COURT,

Jan Horbaly

Jan Horbaly
Clerk

Dated: January 22, 1999

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

JAN 22 1999

JAN HORBALY
CLERK

cc: RAMSEY M. AL-SALAM
RONALD W. REAGIN

VECTRA FITNESS V TNWK CORPORATION, 98-1192
(DCT - 96-CV-1892)

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* Note: Pursuant to Fed. Cir. R. 47.6, this order is not *
* Citable as precendent. It is a public record. *
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